

Notice of Allowability

Application No.

10/826,081

Examiner

Kagnew H. Gebreyesus

Applicant(s)

KIMOTO ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to December 12, 2005.
2. ☒ The allowed claim(s) is/are 5, 7-19, 12-16.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☒ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

DETAILED ACTION

Status of Claims:

Claims 1-4, 6 and 11 have been cancelled. Claims 5, 7, 8, 10, 12 and 13 have been amended and claims 14-16 have been added. Therefore, claims 5, 7-10 and 12-16 are currently pending in the application.

The following is an examiner's statement of reasons for allowance:

Michio Ito et al (US 5,679,557) teach a process of asymmetrically reducing 1-phenyl-2-oxo-propane derivatives with microorganisms including *Torulaspora delbrueckii* or a preparation thereof. Specifically, Michio Ito et al in example 140 teach a process of preparing an optically pure (S)-1-(3,4-dimethoxyphenyl)-2-propanol by a fermentation method comprising the microorganism *Torulaspora delbrueckii* or a preparation thereof (see page 9 column 1, line 60-65 and example 140 in Michio Ito et al). However Michio Ito et al do not disclose the sequence of the enzyme that catalyzes the reaction. In addition the strain of *Torulaspora delbrueckii* or the preparation thereof used by Michio Ito et al namely, IFO 0381 is different from the recombinantly produced and purified carbonyl reductase isolated from applicant's strain, namely, *Torulaspora delbrueckii* JCM5921. Therefore given that Michio Ito et al have not isolated the specific gene encoding the specific carbonyl reductase which catalyses the specific reaction for the preparation of an optically pure (S)-1-(3,4-dimethoxyphenyl)-2-propanol and have not disclosed the specific polynucleotide or polypeptide structure responsible for this reaction claims 5, 7-10, 12-16 have been allowed in particularly view of In re Deuel wherein the

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court ruled that a specific sequence would not have been obvious in the absence of other prior art that specifically suggests claimed sequence was envisioned and therefor obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee.


Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance." enzyme and characterized it to be a

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kagne H. Gebreyesus whose telephone number is 571-272-2937. The examiner can normally be reached on 8:30 am-5: 30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Achutamurthy ponnathapura can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kagne H. Gebreyesus PhD.


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